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EXAMINER

MARCHESCHI, MICHAEL A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

With respect to the IDS filed 12/12/05, document DE 19926117 has been considered only to the extent that it appears on the International search report, however, since a translation of this document has not been provided, the *substance* disclosed by said document is not being fully considered.

Claims 4, 5 and 8-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4, 5 and 8-13 are indefinite because they depend on withdrawn claims.

Claim 13 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The films capable of being polished do not further limit the slurry in terms of its compositional background.

Claims 1, 4, 5 and 7-13 are rejected under 35 U.S.C. 103(a) as being obvious over Uchida et al. (630) in view of Sameshima et al. (624) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1, 7-11 and 13 are rejected under 35 U.S.C. 102(a) as being anticipated by EP 1260607 for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being obvious EP 1260607 in view of Uchida et al. (630) and/or Sameshima et al. (624) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1, 4, 5 and 7-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Kurata et al. (669) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1, 4, 5 and 7-13 are provisionally rejected on the ground of nonstatutory obviousness-type double (ODP) patenting as being unpatentable over claims 1-11 of copending Application No. 10/517,049 for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1, 4, 5 and 7-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/513,002 for the same reasons set forth in the previous office action which are incorporated herein by reference.

Applicant's arguments filed 6/6/08 have been fully considered but they are not persuasive.

With respect to the 112 rejection, applicant arguments are not persuasive because a claim that depends on a withdrawn claim is indefinite.

With respect to the objection, applicants arguments are not persuasive because claim 13 is in improper dependent form for failing to further limit the subject matter of a previous claim, as defined above. Applicants would appear to be arguing the definiteness of this claim, however, the examiner did not reject the claim based on an indefiniteness problem.

With respect to the rejection based on Uchida et al. (630) in view of Sameshima et al. (624), applicants argue that there is no reason or motivation to select the specific triazoles pointed out in the office action from the list defined by Uchida. It would appear that applicants are presenting arguments analogous to “picking and choosing”. This is not persuasive because it is not picking and choosing to select one element from one list, however long the list may be and when the species is clearly named, the selection from a long list does not avoid a 103 rejection. See Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990) (The claimed compound was named in a reference which also disclosed 45 other compounds. The Board held that the comprehensiveness of the listing did not negate the fact that the compound claimed was specifically taught. See also *In re Sivaramakrishnan*, 673 F.2d 1383, 213 USPQ 41 (CCPA 1982). Applicants further argue that Uchida does not disclose that capability according to the claimed invention. This is not persuasive because this capability is immaterial because the claimed triazoles are still known to be used.

Applicants argue that Sameshima et al. does not disclose the claimed specific triazoles. Although this may be true, the examiner did not rely on this reference for this teaching. It would appear that applicants are arguing this reference alone and not in the combination as applied and one cannot show nonobviousness by attacking references individually where the rejections are

based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants also argue that even if such a combination was made, they show unexpected results. This is not persuasive because, without going into further detail, the data presented is for compositions not commensurate in scope with what is claimed (i.e. the amounts, MW, etc. or other specifics defined in the examples are not consistent with what is claimed (i.e. claims are much more broader in scope are not consistent with the components defined in the tables, thus how can narrow compositions established unexpected results for extremely broad claimed compositions).

With respect to the rejection based on EP 1260607 alone, applicants appear to argue that since an aminotriazole is not used in any example, the rejection under 102 is improper. Just because the example does not define this component does not make the rejection improper because a reference can be used for all it realistically teaches and is not limited to the disclosure in the examples and this reference clearly teaches, as outline in the previous office action and above, in sections [0022]-[0028] a composition comprising a mixture of benzotriazole, imidazole (i.e. methylimidazole) and aminobenzotriazole (or other triazole having amino groups), as is apparent because section [0022] refers to an amino substituted azole (i.e. triazole). It would also appear that applicants are arguing no reasons to select amino triazole". This is not persuasive because this component is specifically named (i.e. the statement that the azole (i.e. triazole listed) can be substituted with an amino groups specifically names this component and as defined above, this does not avoid a 102 rejection).

With respect to the rejection based on EP 1260607 in view of Uchida et al. (630) and/or Sameshima et al. (624), applicants argue that no motivation is apparent to combine the references because the functions of the components are different. This is not persuasive because the EP reference clearly teaches amino triazoles (see above) and the claimed material is a well known amino triazole, as is evident by the secondary references. The functionality of the components is immaterial because the examiner has only applied the secondary references to show what is otherwise a known amino triazole (primary references uses an amino triazole). Applicants also argue unexpected results, however, this is not persuasive for the reasons defined above with respect to the first rejection.

With respect to the rejection based on Kurata et al. (669), applicants argue that this reference does not disclose any examples that use the claimed combination, thus the rejection is improper. Just because the examples do not define this mixture does not make the rejection improper because a reference can be used for all it realistically teaches and is not limited to the disclosure in the examples and this reference clearly teaches, as outline in the previous office action and above, that the claimed three materials can be used in combination. Applicants also appear to be arguing unexpected results, however, unexpected results can not be used to overcome a 102 rejection.

With respect to the ODP rejection based on 10/517,049, applicants argue that the examiners use of the specification in an ODP rejection is improper. This is not persuasive because claim 5 teaches that the anticorrosive can be a mixture of (1) a material having a triazole skeleton and (2) a material having an imidazole skeleton and one can look to the specification for a *definition* of what is meant by the claimed language. Even without the definitions in the

specification, it can be seen that the disclosure in this claims broadly reads on the claimed materials. It is also noted that just because the rejection is a provisional ODP rejection does not preclude it from being made.

With respect to the ODP rejection based on 10/513,002, applicants argue that the examiners use of the specification in an ODP rejection is improper. This is not persuasive because claim 5 teaches that the anticorrosive can be a mixture of (1) a material having a triazole skeleton and (2) a material having an imidazole skeleton and one can look to the specification for a *definition* of what is meant by the claimed language. Even without the definitions in the specification, it can be seen that the disclosure in this claims broadly reads on the claimed materials. It is also noted that just because the rejection is a provisional ODP rejection does not preclude it from being made.

In all of the above rejections applied, applicants are reminded of the case law that states that it is prima facie obvious to combine two or more materials disclosed by the prior art to form a third material that is to be used for the same purpose. In re Kerkhoven 205 USPQ 1069.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael A Marcheschi/
Primary Examiner, Art Unit 1793